REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed June 2, 2005. In the Office Action, the Examiner notes that claims 1-25 are pending and rejected. By this response, claims 1 and 10 have been amended.

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

Amendments to the claims

The amendments to the claims are fully supported by the Specification. For example, the amendments to claim 1 are supported at least by page 44, line 21, to page 45, line 2. Thus, no new matter has been added and the Examiner is respectfully requested to enter the amendments.

Rejections under 35 U.S.C. §103

Claims 1-14, 17 and 19-25

The Examiner has rejected claims 1-14, 17 and 19-25 under 35 U.S.C. §103(a) as being unpatentable over Wang (U.S. Patent 6,675,385, hereinafter "Wang") in view of Legall et al. (U.S. Patent 6,005,565, hereinafter "Legall"). The Applicants respectfully traverse the rejection.

The Applicants' independent claim 1 recites:

> "1. A method for searching a program guide database, comprising: receiving, from service provider equipment, an interactive program guide (IPG) comprising a plurality of IPG pages encoded as video streams, each of said IPG pages including a search object and a portion of IPG imagery;

receiving one or more search criteria via user interaction with said search object;

sending a request for a search along with the one or more search criteria to a head end of an information distribution system;

receiving at least one search result from the service provider equipment; and

wherein the program guide database is searched at the service provider equipment."

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Wang and Legall references, alone or in combination, fail to teach or suggest all of the limitations recited in claim 1, and thus fail to teach or suggest the Applicants' invention as a whole.

Specifically, the Wang and Legall references fail to teach or suggest at least receiving "a plurality of IPG pages encoded as video streams, each of said IPG pages including a search object".

The Wang reference discloses, generally speaking, formatting EPG data as HTML web pages and broadcasting the HTML-format EPG in an MPEG-2 data stream. Specifically, the Wang reference discloses (emphasis added below):

> "The group of generated EPG Web pages is forwarded to Data Streamer 18 and MPEG-2 Encoder 20. Data Streamer 18 formats the group of EPG Web pages into the data packet structure of an MPEG-2 transport stream while retaining the original HTML format. An MPEG-2 system is a multiple channel digital television system wherein each of the multiple channels has a plurality of multiplexed digital television channels composed of MPEG-2 data packets. Data Streamer 18 also generates control maps that associate EPG Web pages with their corresponding location within the MPEG-2 data stream. The generated MPEG-2 transport stream data packets containing the EPG Web pages in HTML format are broadcast in standard MPEG-2 data streams over the downstream broadcast network 22 to settop box 24." (column 4, lines 9-23)

Thus, the Wang reference clearly discloses that EPG web pages are broadcast in HTML format. In contrast, the present invention teaches that a plurality of IPG pages encoded as video streams are received from service provider equipment. HTML is very different than video. For example, the HTML format of the EPG web pages of the Wang

reference requires the set top box to "further include[s] a World Wide Web browser program 32 running on a microprocessor" (column 3, lines 49-50). In contrast, the present invention does not require the set top box to have a World Wide Web browser.

The Examiner alleges (emphasis added below):

> "The Wang reference discloses a video distribution channel. 'The digital MPEG-2 channel 48 consists of several multiplexed data streams: multiplexed digital video and audio data streams 58A, simulcast data streams 58B and broadcast data streams 58C' (Col 7, Lines 31-34). Although HTML is used, the end result is a visual presentation on the user screen/TV (i.e. Video)." (page 2 of the Office Action mailed on 6/2/05)

However, the Applicant respectfully submits that it is not merely the "end result" that is being claimed in claim 1. Instead, it is the totality of the method recited in the claim, and as discussed above, the Wang reference does not teach or suggest receiving "a plurality of IPG pages encoded as video streams, each of said IPG pages including a search object" as recited in the claim.

Moreover, the Examiner acknowledges:

> "Wang fails to explicitly disclose, 'receiving one or more search criteria via user interaction with said search object', 'sending a request for a search along with the one or more search criteria to a head end of an information distribution system', 'receiving at least one search result from the service provider equipment' or that 'the program guide database is searched at the service provider equipment'." (page 3 of the Office Action mailed on 6/2/05)

The Examiner then relies on the Legall reference to bridge the substantial gap between the Wang reference and the present invention. However, the Legall reference fails to bridge this gap.

The Legall reference discloses a "power search tool that enables a user to search an electronic program guide and other information resources with one search" (abstract). However, the Legall reference also does not disclose receiving "a plurality of IPG pages encoded as video streams, each of said IPG pages including a search object".

Furthermore, there is no motivation to combine the Legall reference with the Wang reference.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

The Examiner alleges the motivation to combine the Wang and Legall references is "to allow a user to 'perform searches that can be carried across a variety of information platforms' (Col 1, Lines 26-27)" (page 5 of the Office Action mailed on 6/2/05), citing a portion of the Legall reference. However, the Applicants respectfully disagree that the Examiner's allegation provides motivation to combine, because the Wang reference teaches away from combination with the portion of the Legall reference relied upon by the Examiner, and this outweighs the alleged source of motivation to combine provided by the Examiner.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

The Examiner is relying on the Legall reference to allegedly disclose, inter alia, the claimed "sending a request for a search along with the one or more search criteria to a head end of an information distribution system" as recited in the claim. However, this conflicts with the disclosure of the Wang reference: "The present invention provides an EPG solution for a one way broadcast digital TV network" (column 2, lines 5-7, emphasis added). Thus, the Wang reference teaches away from sending a search request to a headend because the Wang reference is designed for a one way broadcast digital TV network.

Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)

The Applicants respectfully submit that the teaching away of the Wang reference, in regards to combination with the portion of the Legall reference relied upon by the Examiner, outweighs the motivation to combine alleged by the Examiner.

As such, for the reasons discussed herein, the Applicants respectfully submit that independent claim 1 is patentable under 35 U.S.C. §103 over the Wang and Legall references. Furthermore, since independent claim 20 has substantially similar relevant limitations as those discussed above in regards to claim 1, claim 20 is also patentable under 35 U.S.C. §103. Moreover, since all of the dependent claims depend, either directly or indirectly, from claims 1 or 20, and recite additional limitations therefrom, these dependent claims are also patentable.

Claims 15 and 16

The Examiner has rejected claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Legall and in further view of Leary (U.S. Patent 6,425,133, hereinafter "Leary"). The Applicants respectfully traverse the rejection.

Claims 15 and 16 depend directly or indirectly from independent claim 1 and include all of its limitations. Moreover, independent claim 1 is patentable for reasons discussed above. As such, dependent claims 15 and 16 are also patentable for at least the same reasons discussed above in regards to claim 1.

Claim 18

The Examiner has rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Legall and in further view of Thomas et al. (U.S. Patent 5,666,645, hereinafter "Thomas"). The Applicants respectfully traverse the rejection.

Claim 18 depends directly or indirectly from independent claim 1 and includes all of its limitations. Moreover, independent claim 1 is patentable for reasons discussed above. As such, dependent claims 15 and 16 are also patentable for at least the same reasons discussed above in regards to claim 1.

OFFICIAL NOTICES

The Examiner takes numerous Official Notices in the Office Action. For example see pages 6-8 and 10-11 of the present Office Action. Applicant hereby traverses each

Official Notice. The Examiner alleges that certain apparatuses and/or methods are well known in the art. However, the Applicant respectfully disagrees. These apparatuses and/or methods may not be well know within the specific art of the present invention and as specifically recited in their respective claims. Furthermore, it may not be well known to combine the allegedly well known apparatuses and/or methods with other apparatuses and/or methods recited in the respective claims or in other claims from which the respective claims may depend.

CONCLUSION

Thus, Applicants submit that none of the claims, presently in the application, are obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. or Stephen Guzzi at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 8/30/05

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